

R E M A R K S

The Examiner is respectfully requested to return a copy of the Form PTO/SB/8A dated June 14, 2001 with the Examiner's initials next to the cited document. The document cited on said Form PTO/SB/08A dated June 14, 2001 corresponds to U.S. patent publication 2001/0031835A1, which was cited in applicants' Form PTO/SB/08A dated March 11, 2003.

Claim 1 was amended to include features of claim 3.

New claim 22 is supported in the specification on page 9, line 12 to page 10, line 7.

New claim 23 is supported in the specification on page 11, lines 14 to 20.

New claim 24 is supported in the specification on page 12, lines 20 to 23.

Claims 1 to 4 and 8 to 17 were rejected under 35 USC 112, first paragraph, for the reasons set forth in Item Nos. 2 and 3 on page 2 of the enclosed Office Action.

The position was taken in the Office Action that there is "no description of the crosslinked product in the specification". Applicants respectfully disagree with this position.

In the paragraph bridging pages 8 and 9 of the specification, the copolymer of (meth)acrylic esters of component (A) is stated as having "portions for crosslinking which can be

crosslinked with the crosslinking agent of component (B)". It is respectfully submitted that this is a disclosure of a "crosslinked product".

It is therefore respectfully submitted that the claims comply with all the requirements of 35 USC 112.

The Office Action did not include any prior art rejection for claims 8 to 17.

Claims 1 to 3 were rejected under 35 USC 102 as being anticipated by each of Hauber USP 4,033,918, Kealy et al. USP 4,418,120 or Tokanuga USP 5,279,896 for the reasons set forth in Item No. 6 at the top of page 3 of the Office Action.

Haubel discloses a crosslinked polymer in the Example and an ethoxylated phenol in claim 6. However, the phenol compound as defined in applicants' present claim 1 is substantially different from the ethoxylated phenol disclosed by Haubel. The ethoxylated phenol in Haubel is used as an emulsifying agent. The phenol compound in the presently claimed invention is used for suppressing hydrolysis of an easily hydrolyzable material such as a film of acetylcellulose to which the adhesive composition of the present invention is applied (see page 12, lines 11 to 15 of the present specification). The presently claimed invention is therefore not anticipated or rendered obvious by Haubel.

Kealy et al. disclose using a hindered phenol antioxidant as component (b) in their adhesive (see claim 1 in Kealy et al.). However, Kealy et al. fail to disclose the use of the phenol

compounds as defined in applicants' present claim 1 (see column 7, lines 61-68 in Kealy et al.). Kealy et al. fail to disclose or suggest the phenol compounds as defined in applicants' claim 1 which are effective for suppressing hydrolysis of an easily hydrolyzable material such as a film of acetylcellulose to which the adhesive composition of the present invention is applied. It is therefore respectfully submitted that the presently claimed invention is not anticipated or rendered obvious by Kealy et al.

Tokunaga et al. disclose a vibration-damping pressure-sensitive adhesive composition containing a crosslinked structure of a copolymer comprising (A) a main monomer comprising an alkyl(meth)acrylate containing from 8 to 12 carbon atoms in the alkyl moiety thereof, (B) a carboxyl containing monomer whose homopolymer has a glass transition temperature of 50°C or more, (C) a polyfunctional free radically polymerizable monomer as a crosslinking agent and (D) a hindered phenol antioxidant (claim 1 of Tokunaga et al., abridged).

Tokunaga et al. exemplify only two kinds of hindered phenol antioxidants, namely pentaerythrityl-tetrakis[3-(3,5-di-tert-butyl-4-hydroxyphenyl)propionate] and 2,4-bis(n-octylthio)-6-(4-hydroxy-3,5-di-t-butylanilino)-1,3,5-triazine (column 5, lines 6-10 and Examples 1-3 of Tokunaga et al.). Tokunaga et al. fail to disclose the phenol compounds as claimed in applicants' present claim 1. Tokunaga et al. fail to disclose that the phenol compounds defined in applicants' claim 1 which are

effective in suppressing hydrolysis of an easily hydrolyzable material such as a film of acetylcellulose to which the adhesive composition of the present invention is applied. It is therefore respectfully submitted that the presently claimed invention is not anticipated or rendered obvious by Tokunaga et al.

Claims 1 to 4 were rejected under 35 USC 102 as being anticipated by Albright et al. USP 4,492,724, Blake USP 4,569,960, Lee USP 5,331,040, Crandall et al. USP 5,424,122, Bauer et al. USP 5,623,014 or Razavi USP 5,629,365 for the reasons set forth in Item No. 8 at the bottom of page 3 of the Office Action.

Albright et al. disclose a humidity-resistant wet-stick pressure-sensitive adhesive composition using a tackifier system comprising octyl phenol adducts of an ethylene oxide polymer (claim 4, abridged, of Albright et al.). However, the phenol compound as defined in applicants' present claim 1 is substantially different from the octyl phenol adducts of an ethylene oxide polymer disclosed by Albright et al. with respect to chemical structure and the purpose of using them. The octyl phenol adducts of an ethylene oxide polymer disclosed by Albright et al. is used in a tackifier system. In contrast to Albright et al., as previously discussed, the phenol compound in the presently claimed invention is used for suppressing hydrolysis of an easily hydrolyzable material such as a film of acetylcellulose to which the adhesive composition of the present invention is

applied (see page 12, lines 11 to 15 of the present specification). The presently claimed invention is therefore not anticipated or rendered obvious by Albright et al.

Blake discloses a water-dispersible adhesive in one of the embodiments of which a phenol derivative is used as one of the ingredients of the plasticizing component (see the Table in column 8, I52 and I62; claim 9 in Blake). However, the phenol compound as defined in applicants' present claim 1 is substantially different from the phenol derivative disclosed by Blake. The phenol derivative disclosed by Blake is an ethoxylated octyl phenol or an ethoxylated nonyl phenol and is irrelevant with respect to the phenol compound as defined in applicants' present claim 1. The chemical structure and the purpose of using such phenol compound in Blake are quite different from the phenol compound recited in the presently claimed invention. As previously discussed, the phenol compound in the presently claimed invention is used for suppressing hydrolysis of an easily hydrolyzable material such as a film of acetylcellulose to which the adhesive composition of the present invention is applied. The presently claimed invention is therefore not anticipated or rendered obvious by Blake.

Lee discloses an adhesive composition with a functional filler in which formaldehyde resins or novolak resins, which are phenol compounds, are used as a crosslinking agent (column 2, lines 52-65 of Lee). It appears that the Examiner intended to

refer to column 2, instead of column 3 of Lee in Item 8, line 5 of page 3 of the Office Action. The formaldehyde resins or novolak resins disclosed in Lee are quite irrelevant with respect to the phenol compounds of the presently claimed invention. The chemical structure and the purpose of using such phenol compounds in Lee are substantially different from the phenol compound recited in the presently claimed invention. As previously discussed, the phenol compound in the presently claimed invention is used for suppressing hydrolysis of an easily hydrolyzable material such as a film of acetylcellulose to which the adhesive composition of the present invention is applied. The presently claimed invention thus is not anticipated or rendered obvious by Lee.

Crandall et al. disclose a neutral nonionic latex for a water-borne PSA coating system in which ethoxylated alkylphenols are used as an emulsifier. However, the chemical structure and the purpose of using the ethoxylated alkylphenols of Crandall et al. are substantially different from the phenol compound recited in the presently claimed invention. Crandall et al. fail to teach or suggest the use of phenol compounds as defined in applicants' present claim 1, which phenol compounds are useful for suppressing hydrolysis of an easily hydrolyzable material such as a film of acetylcellulose to which the adhesive composition of the present invention is applied. The presently

claimed invention is therefore not anticipated or rendered obvious by Crandall et al.

Bauer et al. disclose a dispersion or solution of a free radical polymer, polycondensate or polyadduct in which a reaction product of alkylene oxides with phenols or alkylphenols are used as an emulsifier. Bauer et al. fail to teach the use of phenol compounds as defined in applicants' present claim 1. Bauer et al. fail to teach or suggest phenol compounds which are useful for suppressing hydrolysis of an easily hydrolyzable material such as a film of acetylcellulose to which the adhesive composition of the present invention is applied. The presently claimed invention is thus not anticipated or rendered obvious by Bauer et al.

Razavi discloses aqueous lattices adapted to forming visible light transparent, coherent polymeric films comprising colloidal particles of a UV-absorbing polymer less than 5 micrometers in diameter (ABSTRACT of Razavi). Razavi teaches only that such lattices can be enhanced by a variety of other common coating additives, one of which includes antioxidants, such as hindered phenols (column 5, lines 27-32 of Razavi). Only Irganox 1010, tetrakis[methylene(3,5-di-tert-butyl-4-hydroxyhydrocinamate)]methane and Irganox 245, triethylene glycol bis[3-(3'-tert-butyl-4'-hydroxy-5'-methylphenyl)propionate] are exemplified in Razavi (column 8, lines 56-64 of Razavi). Razavi fails to teach the use of the phenol compounds as defined in

Application No. 09/829,061
Amdt. dated July 22, 2003
Reply to Office Action of April 28, 2003

applicants' present claim 1. Razavi also fails to teach or suggest phenol compounds which are useful for suppressing hydrolysis of an easily hydrolyzable material such as a film of acetylcellulose to which the adhesive composition of the present invention is applied. The presently claimed invention thus is not anticipated or rendered obvious by Razavi.

In view of the above, it is respectfully submitted that the presently claimed invention is not taught or suggested by the cited art. Withdrawal of the prior art rejections and allowance of the application are respectfully requested.

If the Examiner has any comments, questions, objections or recommendations, the Examiner is invited to telephone the undersigned at the telephone number given below for prompt action.

Respectfully submitted,


RICHARD S. BARTH
REG. NO. 28,180

FRISHAUF, HOLTZ, GOODMAN & CHICK, P.C.
767 THIRD AVENUE - 25TH FLOOR
NEW YORK, NEW YORK 10017-2023
Tel. Nos. (212) 319-4900
 (212) 319-4551/Ext. 219
Fax No. (212) 319-5101
E-Mail Address: BARTH@FHGC-LAW.COM
RSB/ddf